

## **REMARKS**

### **Formal Matters**

Claims 1, 12-13, 46, 53, 58, 190-192 and 194-222 are pending after entry of the amendments set forth herein.

Claims 203-218 are currently withdrawn from examination.

Claims 1, 12, 13, 46, 53, 58, 190-192, 194-202, 219 and 220 were examined.

Claims 1, 12, 13, 46, 53, 58, 190-192, 194-199, 202, 219 and 220 were rejected.

Claims 200 and 201 were objected to, but indicated to contain allowable subject matter.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

### **The Office Action**

#### **Claim Rejected Under 35 U.S.C. Section 102(e) (Vierra et al.)**

In the Official Action of January 12, 2010, claims 190-192, 194-196, 198 and 202 were rejected under 35 U.S.C. Section 102(e) as being anticipated by Vierra et al., U.S. Patent No. 5,749,892.

The Examiner asserted that Vierra et al. discloses a device that includes a contact member (15,17) shapeable to engage the surface of a beating heart.

Applicants respectfully traverse. Although Vierra et al. discloses that the contact members 15,17 can be shaped to conform to the curvature of the outer surface of the heart (column 6, line 65 – column 7, line 1), or, alternatively, may be shaped to conform with other organs or tissue structures (column 7, lines 5-8), it is respectfully submitted that this refers to alternate embodiments and that such shapes are made during the manufacture of the contact members 15,17. It is respectfully submitted that Vierra et al. fails to disclose contact members 15,17 that are shapeable as claimed.

The Examiner further asserted that Vierra et al. discloses that contact members 15, 17 are hollow and made of a malleable material. The Examiner referred to column 9, line 11 of Vierra et al. as support for these assertions.

Applicants respectfully traverse. It is respectfully submitted that column 9, line 11 of Vierra et al. discloses that foot 11a is made of a flexible material. Thus, column 9, line 11 has absolutely nothing to do with contact members 15, 17. Applicants note that this argument was presented in the previous response filed on September 28, 2009. If the Examiner intends to maintain this line of reasoning, Applicants respectfully request the Examiner to answer the substance of the above argument and explain how a disclosure regarding foot 11a can be considered to describe contact members 15, 17.

The Examiner asserted that contact members 15, 17 are made of malleable material. Again Applicants note that column 9, line 11 describes foot 11a, not arms 15, 17. It is respectfully submitted that Vierra et al. does not describe arms 15, 17 as being made of malleable material, contrary to the Examiner's assertion.

The Examiner asserted that the contact members 15, 17 of Vierra et al. are capable of being bent to form a U-shaped configuration. The Examiner did not refer to any specific portion of the disclosure of Vierra et al. to support this assertion.

Applicants respectfully traverse. Applicants have been unable to find any disclosure by Vierra et al. that supports the Examiner's assertion that contact members are capable of being bent to form a U-shaped configuration.

The Examiner further asserted that the "contact member" 15, 17 of Vierra et al. may comprise a flexible tube 78.

It is respectfully submitted that flexible tube 78 of Vierra et al. is not a contact member, but is a vacuum tube that connects a lumen in shaft 3 with the arm 17 (see Fig. 1 and column 8, lines 23-30). To further clarify the distinction of the present invention, claim 190 has been amended above to recite that the flexible tube has a contact surface adapted to contact a surface of the beating heart. Support for this amendment can be found, for example, at Figs. 6A-6B, 23A-23B, the descriptions thereof, and throughout the specification and drawings. It is respectfully submitted that the vacuum tube 78 is not a contact member and does not have a contact surface as claimed.

The Examiner further asserted that the flexible tube 78 of Vierra et al. contains a plurality of particles. The Examiner did not refer to any specific portion of the disclosure of Vierra et al. to support this assertion.

Applicants respectfully traverse. Applicants have been unable to find any disclosure by Vierra et al. that the tube 78 contains a plurality of particles as claimed.

The Examiner further asserted that a malleable member extends along at least a portion of the flexible tube 78 of Vierra et al. The Examiner did identify the "malleable member" in the drawings of

Vierra et al., nor did the Examiner refer to any specific portion of the disclosure of Vierra et al. to support this assertion.

Applicants respectfully traverse. Applicants have been unable to find any disclosure by Vierra et al. that a malleable member extends along at least a portion of the tube 78.

In view of the above amendment and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 190-192, 194-196, 198 and 202 under 35 U.S.C. Section 102(e) as being anticipated by Vierra et al., U.S. Patent No. 5,749,892, as being inappropriate.

**Claim Rejected Under 35 U.S.C. Section 103(a) (Vierra et al. in view of Buckman, Jr. et al.)**

Claims 1, 46, 58 and 221 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Vierra et al., U.S. Patent No. 5,749,892 in view of Buckman, Jr. et al., U.S. Patent No. 5,582,580.

The Examiner asserted that Vierra et al. disclose the invention substantially as claimed except for a device that include a means for introducing positive/negative fluid pressure to the contact member. The Examiner did not specifically identify how Vierra et al. is considered to disclose all of the features of claims 1, 46, 58 and 221.

The Examiner asserted that Buckman, Jr. et al. teaches a contact member 82 that is malleable (Fig. 7, column 9, line 28-column 10, line 63) and that it would have been obvious to modify the device of Vierra et al. to include a means for introducing pressure to the contact member, as taught by Buckman, Jr. et al. in order to provide an alternate means of shaping the contact member that allows the contact member to have a plurality of different shapes.

Applicants respectfully traverse. Applicants note that the cup 82 is not capable of being shaped into a plurality of different shapes prior to said introducing a positive or negative fluid pressure, and then fixed in that different shape by application of the positive or negative fluid pressure. Rather, a source of positive pressure is used, not to fix a shape of the diaphragm 86, but, to the contrary, to change the shape of the diaphragm to as to exert an undulating massaging force. If the diaphragm 86 were fixed in the Buckman, Jr. et al. device, the device would not function for its intended purpose.

The Examiner asserted that the contact member 82 of Buckman, Jr. et al. is malleable. Applicants respectfully submit that Buckman, Jr. et al. does not disclose that member 82 is malleable. Rather, Buckman, Jr. et al. discloses that member 82 has a flexible sidewall 84 (column 9, lines 46-47). To further clarify this distinction, Applicants have amended claim 46 above to recite that said malleable

material providing structural memory to said contact member. It is respectfully submitted that Buckman, Jr. et al. discloses no such malleable member.

Regarding claim 221, it is respectfully submitted that neither Vierra et al. nor Buckman, Jr. et al., whether taken separately or in any proper combination, disclose, suggest or render obvious a device for use in a cardiovascular surgery on the beating heart comprising: a means for stabilizing the beating heart comprising a contact member shapeable to engage the surface of the beating heart; and means for introducing a positive or negative fluid pressure to said contact member, wherein introduction of said positive or negative fluid pressure fixes a present shape of the contact member; wherein said contact member comprises a hollow portion containing a conformable material therein.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1, 46, 58 and 221 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Vierra et al., U.S. Patent No. 5,749,892 in view of Buckman, Jr. et al., U.S. Patent No. 5,582,580, as being inappropriate.

**Claim Rejected Under 35 U.S.C. Section 103(a) (Vierra et al. in view of Buckman, Jr. et al. and Koros et al.)**

Claims 12, 13 and 222 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Vierra et al., U.S. Patent No. 5,749,892 in view of Buckman, Jr. et al., U.S. Patent No. 5,582,580, and further in view of Koros et al., U.S. Patent No. 6,113,534.

It is respectfully submitted that the Examiner has not set forth a prima facie case of obviousness. Koros et al. has an effective filing date of March 19, 1998. The effective filing date of the present claims goes back at least as far as January 27, 1997. Accordingly, it is respectfully submitted that Koros et al. is not prior art against the present claims.

In view of the above remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 12, 13 and 222 under 35 U.S.C. Section 103(a) as being unpatentable over Vierra et al., U.S. Patent No. 5,749,892 in view of Buckman, Jr. et al., U.S. Patent No. 5,582,580, and further in view of Koros et al., U.S. Patent No. 6,113,534, as failing to set forth a prima facie case of obviousness.

**Claim Rejected Under 35 U.S.C. Section 103(a) (Vierra et al. in view Buckman, Jr. et al. and Boyd et al.)**

Claims 53, 197, 199, 219 and 220 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over Vierra et al., U.S. Patent No. 5,749,892 in view of Buckman, Jr. et al. and further in view of Boyd et al., U.S. Patent Application Publication No. 2002/0069884.

It is respectfully submitted that the Examiner has not set forth a prima facie case of obviousness. The paragraphs [0116], [0119], [0112] and [0111] of Boyd et al. are not disclosed in either of the parent applications (08/281,891 and 08/023,778). Accordingly, the effective filing date of Boyd et al., as applied, is October 19, 2001. The effective filing date of the present claims goes back at least as far as January 27, 1997. Accordingly, it is respectfully submitted that Boyd et al. is not prior art against the present claims.

In view of the above remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 53, 197, 199, 219 and 220 under 35 U.S.C. Section 103(a) as being unpatentable over Vierra et al., U.S. Patent No. 5,749,892 in view of Buckman, Jr. et al. and further in view of Boyd et al., U.S. Patent Application Publication No. 2002/0069884, as failing to set forth a prima facie case of obviousness.

#### **Allowable Subject Matter**

Applicants wish to extend their thanks to the Examiner for the indication that claims 200 and 201 contain allowable subject matter.

#### **Conclusion**

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-005CON6.

Respectfully submitted,  
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